

## REMARKS

The official action dated August 8, 2006 has been carefully reviewed. Claims 1-7, 9, 11-16, and 18-51 are pending in this application. Applicants request reconsideration of this application in light of the remarks presented herein.

### CLAIM REJECTIONS BASED ON § 103 - CAREN/HEDSTROM

In the official action, claims 1-7, 9, 11-16, and 18-51 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Pat. No. 6,321,531 to Caren et al. ("Caren") in view of U.S. Pat. No. 4,387,529 to Hedstrom ("Hedstrom").

#### A. The Rejections of Claims 1 and 49

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the official action, the Examiner rejected independent claims 1 and 49 for obviousness. Specifically, the Examiner alleges that Caren contains several of the limitations found in both claims 1 and 49. The Examiner further alleges that Caren fails to disclose a secondary winding having a universal winding configuration and wound in sections, but believes that Hedstrom

teaches that it is conventional in the art to use a transformer including a secondary winding having a universal winding configuration and wound in sections. The Examiner concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to “use a transformer including a secondary winding having a universal winding configuration and wound in sections of Caren, as taught by Hedstrom *for the purpose of reducing intra-winding capacitance and electric field, so as to further improve the performance and efficiency of the transformer.*” (Emphasis added.)

The Examiner’s analysis has failed to at least satisfy the first of the criteria provided above. Specifically, the Examiner has failed to provide any legally sufficient suggestion or motivation, *either in the references themselves or in the knowledge generally available to one of ordinary skill in the art*, to modify the reference or to combine reference teachings. In fact, the only motivation provided by the Examiner is “for reducing intra-winding capacitance and electric field, so as to further improve the performance and efficiency of the transformer”, which is the same unsupported conclusory statement provided in the previous office action. And, as discussed in the response to the previous office action, the Examiner has failed to identify where such a purported motivation can be found in the prior art. Indeed, as before, *the Examiner’s motivation appears to be derived solely from previous arguments presented by the Applicants themselves*. The Examiner simply provides no proper motivation as to why one armed with the disclosure of Caren, specifically, advanced fuel reformer technology, would be motivated to seek out bug zapper technology such as that found in Hedstrom.

In light of the Examiner’s reasons for combining Caren and Hedstrom, it appears that he has improperly engaged in hindsight reconstruction. Because the Examiner has offered only statements provided by the Applicants as the legally required teaching, motivation, and suggestion to combine Caren and Hedstrom, and in light of the overwhelming reasons against such a combination, it appears that the Examiner is using the Applicants’ application as a

roadmap in developing his rejection. That is, the Examiner appears to be using hindsight reconstruction as a substitute for a factual basis for the rejection of the claims under 35 U.S.C. § 103.

Such use of hindsight reconstruction is not proper. "There must be a reason apparent at the time the invention was made to a person of ordinary skill in the art for applying the teaching at hand, or the use of the teaching as evidence of obviousness will entail prohibited hindsight." *In re Nomiya, Kohisa, and Matsumura*, 509 F.2d 566, 184 USPQ 607 (CCPA 1975). "The Patent Office has the initial duty of supplying a factually basis for a rejection under 35 U.S.C. § 103. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *In re Rice*, 481 F.2d 1316, 178 USPQ 478, 479 (CCPA 1973).

This improper use of hindsight reconstruction by the Examiner is best exemplified through comparison of the 11/15/05 office action with the one being responded to herein. Comparing the Examiner's analysis from each shows that the Examiner has merely exchanged the reference cited in combination with Caren in the 11/15/05 office action for Hedstrom without any change in his improper motivation in rejecting claims 1 and 49. Thus, it is apparent that the Examiner simply went on a shopping trip to pick and choose various features found in the references relied upon in an attempt to gather all of the limitations found in claims 1 and 49. At no time has the Examiner ever presented a proper reason as to why any of these references should actually be combined with one another. Instead, it appears as though he relies upon the Applicants' claims and supporting arguments for both his shopping list and his motivation for combining the references relied upon. Clearly, this is a case of hindsight reconstruction. Therefore, in light of the foregoing discussion, the Examiner has failed to meet his burden in establishing a prima facie case of obviousness.

In light of the Examiner's current position, Applicants respectfully believe a prima facie case of obviousness has not been established. Therefore, the rejections of claim 1 and 49 should be withdrawn by the Examiner.

B. The Rejections of Claim 2-7, 9, 11-16, and 18-24

Claims 2-7, 11-16, and 18-24 are dependent upon claim 1. As a result, the rejections of claims 2-7, 11-16, and 18-24 should be withdrawn for at least the reasons discussed in regard to claim 1.

C. The Rejection of Claim 25

Claim 25 has been amended to include limitations similar to those found in claims 1 and 49. As a result, the rejection of claim 25 should be withdrawn for at least the reasons discussed in regard to claims 1 and 49.

D. The Rejections of Claims 26-48

Claims 26-48 are dependent upon claim 25. As a result, the rejections of claims 26-48 should be withdrawn for at least the reasons discussed in regard to claim 25.

E. The Rejections of Claims 50 and 51

Claims 50 and 51 are dependent upon claim 49. As a result, the rejections of claims 50 and 51 should be withdrawn for at least the reasons discussed regarding claim 49.

## CLAIM REJECTIONS BASED ON § 102 - HEDSTROM

In the final official action dated August 8, 2006 claims 25-37 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Hedstrom. Claim 25 has been amended to include limitations similar to those found in claims 1 and 49. As a result, the rejections of claim 25 should be withdrawn for at least the reasons discussed in regard to claims 1 and 49. Claims 26-37 are dependent upon claim 25. As a result, the rejections of claims 26-37 should be withdrawn for at least the reasons discussed in regard to claim 25.

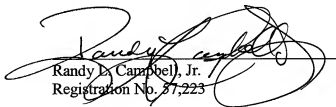
## CONCLUSION

In view of the foregoing remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

It is respectfully requested that this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response. It is further requested that any shortages in extension of time fees or other fees be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg LLP, Deposit Account No. 10-0435 with reference to file 9501-73714.

Respectfully submitted,

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